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10/078,018	02/14/2002	Alain Bebie	BEBI-001	3677

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EXAMINER

HIRL, JOSEPH P

ART UNIT PAPER NUMBER

2121

DATE MAILED: 04/19/2004

2

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/078,018

Applicant(s)

BEBIE, ALAIN

Examiner

Joseph P. Hirl

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-46 are pending in this application.

2. The claims and only the claims form the metes and bounds of the invention.

"Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

3. Examiner's Opinion:

Para 3 above applies. Examiner has full latitude to interpret each claim in the broadest reasonable sense.

***Drawings***

4. The drawings are objected to because of the following informalities:

In accordance with 37 C.F.R. 1.83, all drawings must be complete. To facilitate one of ordinary skill in the art to replicate the invention without undue effort, Figs. 1-6 must be annotated in a conventional manner.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-15, 20-31 and 33-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. No computer or other hardware are identified in a specific manner with these claims. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-15, 20-31 and 33-46 are rejected under 35 USC 112, first paragraph because current case law (and accordingly, the MPEP) require such a rejection if a 101 rejection is given because when Applicant has not in fact disclosed the practical application for the invention, as a matter of law there is no way Applicant could have disclosed how to practice the undisclosed practical application. This is how the MPEP puts it:

("The how to use prong of section 112 **incorporates as a matter of law** the requirement of 35U.S.C. 101 that the specification disclose as a matter of fact a practical utility for the invention.... If the application fails as a matter of fact to satisfy 35 U.S.C. 101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112."); In re Kirk, '376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) ("Necessarily, compliance with § 112 requires a description of how to use presently useful inventions, **otherwise an applicant would anomalously be required to teach how to use a useless invention.**"). See, MPEP 21107.01 (IV), quoting In re Kirk (emphasis added).

Therefore, claims 1-15, 20-31 and 33-46 are rejected on this basis.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2121

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Burton, III et al (U.S. Pub 2003/0145225, referred to as Burton).

#### **Claim 1**

Burton anticipates an expert system (**Burton**, Fig. 4), comprising an administrative unit (**Burton**, Fig. 4, item 410) with a requester interface (**Burton**, Fig. 4, item 465) for communicating with solution requesters via a communication network (**Burton**, Fig. 4), a provider interface for identification of solution offers by solution providers (**Burton**, Fig. 4, item 405c), and a database in which solution requests are stored according to a given specification (**Burton**, Fig. 4, item 400c) and in which said solution offers are stored with a given specification (**Burton**, Fig. 4, item 430c), for which said administrative unit can perform an analysis of said solution requests (**Burton**, p 0065) and said solution offers and as a result of such an analysis, when a possible solution of a solution provider is found for said solution request, establish a contact between a solution requester and a solution provider (**Burton**, p 0065).

#### **Claim 2**

Burton anticipates a formulation of said solution requests is managed by said administrative unit (**Burton**, Fig. 4, item 430; p 0064).

**Claim 3**

Burton anticipates a formulation of solution requests with said administrative unit is interactive (**Burton**, p 0067).

**Claim 4**

Burton anticipates administrative unit presents a solution requester with questions for the formulation of a solution request (**Burton**, p 0067).

**Claim 5**

Burton anticipates questions and given rules for the formulation of solution requests are stored in said database (**Burton**, Fig. 4, item 400c).

**Claim 6**

Burton anticipates the formulation of said solution requests by said administrative unit can be moderated in such a manner that the questions set by said administrative unit to the solution requester depend upon the answers already given by said solution requester (**Burton**, p 0065; Examiner's Note (EN): a counter relates to past answers).

**Claim 7**

Burton anticipates solution offers are stored in said database (**Burton**, Fig. 4, item 400c).

**Claim 8**

Burton anticipates a solution provider may be connected to said administrative unit via a communication network (**Burton**, Fig. 4, item 400c).

**Claim 9**

Burton anticipates the formulation of solution offers requests is managed by said administrative unit (**Burton**, Fig. 4, item 400c).

**Claim 10**

Burton anticipates the formulation of said solution offers with said administrative unit may be done interactively (**Burton**, Fig. 4, item 400c).

**Claim 11**

Burton anticipates said administrative unit presents a solution provider with questions for the formulation of solution offers (**Burton**, p 0070; EN: para 2 above applies; gathering information to determine if an intrusion has occurred will formulate solutions).

**Claim 12**

Burton anticipates given questions and given rules for the formulation of said solution offers are stored in said database (**Burton**, Fig. 4, item 400c; ps 0064, 0065).

**Claim 13**

Burton anticipates solution offers are evaluated by said administrative unit (**Burton**, p 0065).

**Claim 14**

Burton anticipates a quality value is assigned to the evaluated solution offers (**Burton**, p 0060; EN: threshold values are synonymous with quality values).



**Claim 15**

Burton anticipates quality value is formulated based upon rules stored in said database (**Burton**, p 0060).

**Claim 16**

Burton anticipates solution requesters can be connected to said administrative unit within the framework of a client-server-structure (**Burton**, Fig. 4).

**Claim 17**

Burton anticipates said solution providers can be connected to said administrative unit within the framework of a Client-Server-Structure (**Burton**, Fig. 4).

**Claim 18**

Burton anticipates solution requesters can be connected to said administrative unit via the Internet via a communication network (**Burton**, Fig. 4; ps 0063, 0064).

**Claim 19**

Burton anticipates solution providers may be connected to said administrative unit via the Internet via a communication network (**Burton**, Fig. 4; ps 0063, 0064).

**Claim 20**

Burton anticipates a requester identification along with a solution request is stored in said database (**Burton**, p 0070).

**Claim 21**

Burton anticipates wherein a provider identification along with a solution offer is stored in said database (**Burton**, ps 0068-0070).

**Claim 22**

Burton anticipates solution offers are stored in said database in the form of features and feature conditions (**Burton**, Fig. 4; EN: policy is synonymous with features and feature conditions).

**Claim 23**

Burton anticipates administrative unit filters solution offers to a solution request (**Burton**, Fig. 4; p 0070; EN: data gathering on a per unit constraints (filters) the solution options).

**Claim 24**

Burton anticipates administrative unit presents the solution requester with suitable solution offers (**Burton**, Fig. 4; ps 0068-0070).

**Claim 25**

Burton anticipates administrative unit presents a solution requester with suitable solution providers (**Burton**, Fig. 4; ps 0068-0070).

**Claim 26**

Burton anticipates solution requester can send inquires to said solution provider on the presentation of said solution offers (**Burton**, Fig. 4; ps 0068-0070).

**Claim 27**

Burton anticipates inquiries are first transferred to said administrative unit and then forwarded to an appropriate solution provider (**Burton**, Fig. 4, item 400c).

**Claim 28**

Burton anticipates request to a solution provider is set up according to a definite specification (**Burton**, Fig. 4; p 0065; EN: policy is the solution source).

**Claim 29**

Burton anticipates a solution requester may explicitly exclude a solution provider (**Burton**, Fig. 4; p 0068; EN: dropping a "deny" filter into the network to shun subsequent traffic will exclude a solution provider).

**Claim 30**

Burton anticipates a solution provider can communicate an offer to the solution requester upon specific request (**Burton**, Fig. 4; p 0069).

**Claim 31**

Burton anticipates solution provider and said solution requester can be connected via a communication network (**Burton**, Fig. 4).

**Claim 32**

Burton anticipates solution provider and the solution requester can be connected via the Internet in a client-client-relation (**Burton**, Fig. 4).

**Claim 33**

Burton anticipates a process of filtering of suitable solutions takes place according to given facts and given rules (**Burton**, p 0068).

**Claim 34**

Burton anticipates solutions found are stored in said database along with an assigned provider identification (**Burton**, Fig. 4; p 0069).

**Claim 35**

Burton anticipates solution requests are stored in said database (**Burton**, Fig. 4; ps 0068-0069).

**Claim 36**

Burton anticipates solution requests are statistically evaluated (**Burton**, Fig. 4; p 0069).

**Claim 37**

Burton anticipates administrative unit has an interface for one or more specialists (**Burton**, Fig. 4; item 450)..

**Claim 38**

Burton anticipates one or more specialists can be connected to said administrative unit via a communication network (**Burton**, Fig. 4; item 450).

**Claim 39**

Burton anticipates one or more specialists can store solutions in said database (**Burton**, Fig. 4).

**Claim 40**

Burton anticipates one or more specialists can specify questions and rules for formulation and storage of said solution requests (**Burton**, p 0094).

**Claim 41**

Burton anticipates one or more specialists can specify questions and rules for formulation and storage of said solution offers (**Burton**, p 0094).

**Claim 42**

Burton anticipates one or more specialists can specify rules for filtering of solution offers for a solution request (**Burton**, p 0094).

**Claim 43**

Burton anticipates one or more specialists can receive offers stored in database (**Burton**, p 0093).

**Claim 44**

Burton anticipates one or more specialists can receive requests stored in database (**Burton**, p 0100).

**Claim 45**

Burton anticipates one or more specialists can receive results of solution request and solution offer matching (**Burton**, ps 0100, 0101).

**Claim 46**

Burton anticipates (a) an administrative unit communicates with said solution requesters using a requester interface via a communication network(**Burton**, Fig. 4); (b) said solution requests are stored with a given specification (**Burton**, ps 0069); (c) said solution offers are stored with a given specification (**Burton**, ps 0068-0069); (d) said administrative unit analyzes said solution requests and said solution offers (**Burton**, ps 0068-0069); and (e) upon finding a possible solution of a solution request by a solution provider, said administrative unit establishes a contact between said solution requester and said solution provider (**Burton**, ps 0068-0069).

***Conclusion***

11. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

- Solomon, U.S. Pub 2003/0233305
- Jennings et al, U.S. Pub 2004/0025186
- Ginter et al, U.S. Pub 2004/0054630

12. Claims 1-46 are rejected.

***Correspondence Information***

Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (703) 308-3179.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,  
Washington, D. C. 20231;

or faxed to:

(703) 746-7239 (for formal communications intended for entry);

or faxed to:

Application/Control Number: 10/078,018  
Art Unit: 2121

Page 14

(703) 746-7290 (for informal or draft communications with notation of  
"Proposed" or "Draft" for the desk of the Examiner).

Hand-delivered responses should be brought to:

Receptionist, Crystal Park II

2121 Crystal Drive,

Arlington, Virginia.

A handwritten signature in black ink, appearing to read 'J. Hirl', is written over the printed name 'Joseph P. Hirl'.

Joseph P. Hirl

April 16, 2004